

Appl. No. : 10/066,414
Filed : February 1, 2002

COMMENTS

Claims 1-18 and 20 remain pending in the present application.

Applicants would initially like to thank Examiner Basinger for the courteous interview extended to Applicants' counsel, Michael Guiliana, on May 21, 2003. During the interview, Applicants' counsel explained why the presently pending claims clearly and non-obviously define the prior art and explained why the claims are fully supported by the original specification. The substance of the interview is reflected in the comments set forth below.

On the basis of the interview and the response to the Office Action mailed November 20, 2002, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the following supplemental comments.

All Pending Claims Fully Comply With 35 U.S.C. §§ 112 and 251

Claims 13-20 stand rejected under 35 U.S.C. § 112 1st paragraph as not being enabled, and under § 251 as being based on new matter. Applicants respectfully traverse this rejection.

It is well established that "[t]he claims in [a] reissue application must be for subject matter which the applicant had the right to claim in the original patent." MPEP § 1411.02. Further, it is well established that an applicant has the right to claim any subject matter properly disclosed in a patent application.

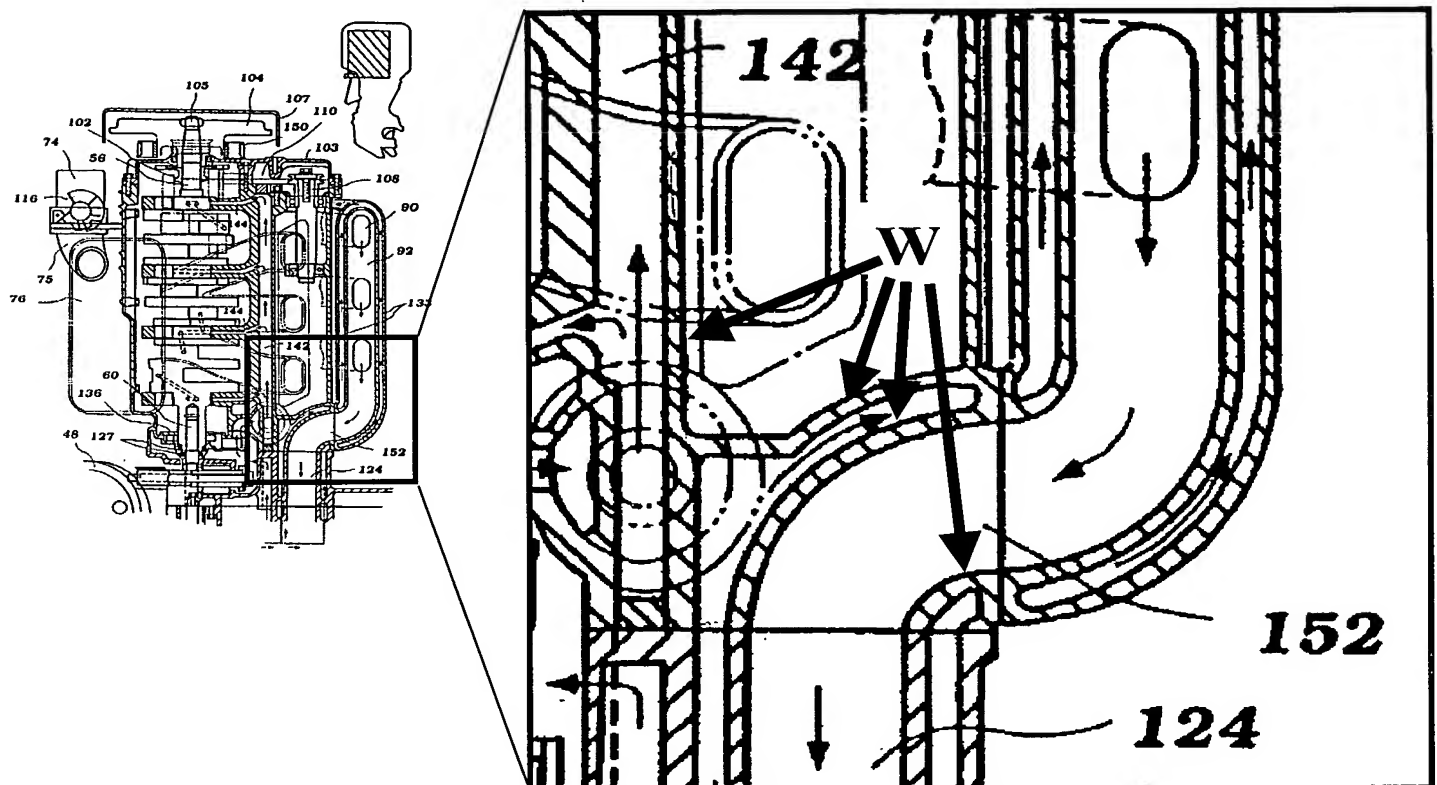
It is also well established that:

"To comply with the written description requirement of 35 U.S.C.112,para.1,or to be entitled to an earlier priority date or filing date under 35 U.S.C.119,120, or 365(c),each claim limitation must be expressly, implicitly, or **inherently** supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone* ,146 F.3d 1348,1353, 47 USPQ2d 1128,1131 (Fed.Cir.1998).

MPEP § 2163 (emphasis added).

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During the interview, Applicant's counsel pointed out that the original specification and drawings, when taken together, would convey to one of ordinary skill in the art that the passage 152 illustrated in Figure 2, necessarily passes through the cylinder block of the engine illustrated therein.



For example, as shown in the above, for reproduction and enlargement of Figure 2 of the present application, the walls defining a the passage 152 are formed monolithically with the cylinder block 52. In the enlarged portion of Figure 2 set forth above, certain walls, shown in cross-section, of the cylinder block 52 have been identified with a letter "W." All of these walls W are illustrated with the same cross-hatching, indicating that they are formed in the same part. Additionally, that the main oil gallery identified by the reference numeral 142 and illustrated in the upper left hand portion of the enlargement of Figure 2 set forth above, is formed monolithically with the other walls labeled "W".

The specification makes clear that the main gallery 142 is defined within the cylinder block 52. For example, Applicants respectfully direct the Examiner to the right-hand column of page 2 of the present application, at lines 62-63 where it is disclosed that "the crankshaft 56 is

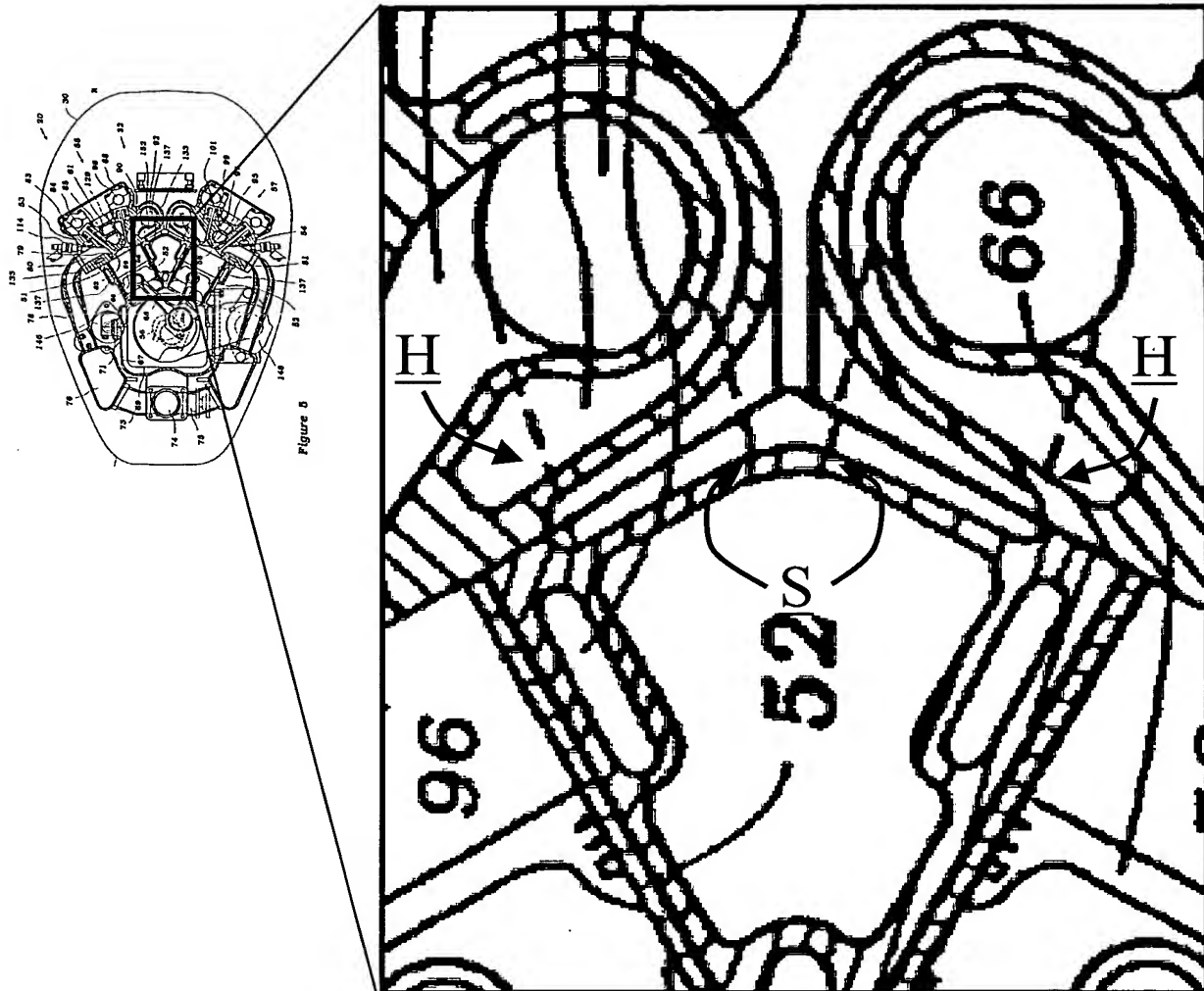
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journalled for rotation with respect to the cylinder block 52.” As shown in Figure 2 of the present application, the crankshaft 56 is illustrated as extending vertically and being supported by main bearing journals (unnumbered). Additionally, in the left-hand column of page 4 of the present application, at lines 20-21, it is disclosed that “branch passages 144 extend from the main gallery 142 for providing lubricant to crankshaft bearings and the like.

Applicants submit that in light of the disclosure of the main gallery 142 and the lubrication of the crankshaft bearings, one of ordinary skill in the art would necessarily conclude that the main gallery 142 is defined within the cylinder block. Thus, in light of the illustration of the walls of the exhaust passage 152 being formed monolithically with the main gallery 142, one of ordinary skill in the art would also conclude that the exhaust passage 152 is necessarily defined by the cylinder block 52.

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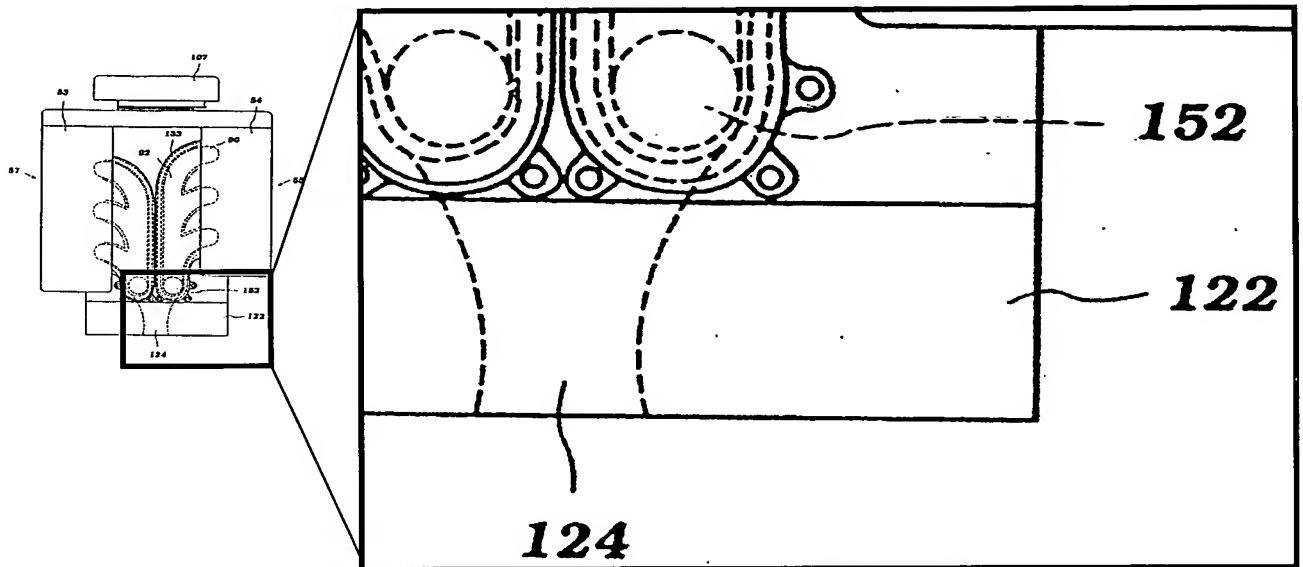
Further support for the Applicants' position that one of ordinary skill in the art would necessarily conclude that the passage 152 is indeed formed in the cylinder block 52, is provided by the illustrations of Figures 5 and 6.



As shown in the above reproduction and enlargement of Figure 5, the exhaust passages 92 which extend downwardly through the cylinder heads along the back side of the engine, curve inwardly toward the cylinder block 52 at the bottom end thereof. In the above enlargement of Figure 5, hidden lines extending from the solid line illustration of the exhaust passages 92, are identified with a letter "H." The remainder of this portion of the passages 92 are illustrated in solid line, identified by the letter "S." Applicants submit that one of ordinary skill in the art would recognize that these hidden and solid lines indicate the inward extension of the exhaust

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passages 92 toward the cylinder block 52. Further, the portion of these lines identified with the letter "S," show that the passages 92 terminate at the cylinder block 52.



Finally, with reference to the above enlargement and reproduction of Figure 6, the opening of the passage 152 is illustrated in phantom line having a circular cross section. The position of these hidden lines at the lower end of the cylinder block, just above the exhaust guide plate 122, correspond to the hidden H and solid S lines identified above with reference to the enlargement of Figure 5.

Additionally, as shown in the enlargement of Figure 6 above, the lower end of the passages 92 are secured to a portion of the engine with bolt flanges (unnumbered). Thus, Applicants submit that one of ordinary skill in the art would conclude that these bolt flanges are intended to connect the exhaust passages to the portion of the cylinder block 52 that extends between the cylinder banks, as illustrated in the above enlargement of Figure 5. Thus, Applicants submit that Claim 13 is fully supported by the present specification and does not constitute new matter.

Further to the comments regarding claims 17 and 18 set forth in the Amendment filed May 29, 2003, Applicants wish to point out that the above enlargement of Figure 6 shows the branch portions merging into a common passage.

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Prior Art Rejections.

The response filed May 29, 2003 addressed each of the rejections of the claims over decided prior art including the Ziegler Nakai et al., and Isogawa references. The comments set forth in the previously filed amendment with respect to these rejections reflects the substance of the interview with respect to these rejections.

Response to Rejection Based on Defective Declaration Under 35 U.S.C. § 251.

Applicants have filed herewith a supplemental Reissue Declaration in compliance with 35 U.S.C. § 251. Thus, the present rejection is moot.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,

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